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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,692	01/14/2002	Hans Rudolf Muller	EPROV 17	8615

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EXAMINER
BERCH, MARK L

ART UNIT	PAPER NUMBER
1624	

NOTIFICATION DATE	DELIVERY MODE
09/29/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

Office Action Summary	Application No.	Applicant(s)	
	10/030,692	MULLER ET AL.	
	Examiner	Art Unit	
	Mark L. Berch	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,29,33,34,40,45-49 and 51-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-13,29,33,34,40 and 45-49* is/are allowed.

6)☒ Claim(s) *14 and 51-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/21/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 52-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new language of $-PO_3(M_1)_2$ is new matter as a substituent on the R4, R5, R7 and R8 choice of substituted hydrocarbon. The original language of $-PO_3M_1$ was clearly wrong.

There are several possibilities as to what the correct language would have been:

I. $-SeO_3(M_1)$

II. $-CO_3(M_1)$, the peracid or salt thereof

III. $-PO_3H(M_1)$

IV. $-PO_3R(M_1)$, where R is an esterifying group.

V. $-PO_3(M_1)_2$ as applicants suggest.

An error can be corrected provided that there is not "reasonable debate" as to what the correct text would be, ***Novo Industries, L.P. vs. Micro Molds Corp.***, 350 F.3d 1348, 69 USPQ2d 1128 (2003). Here, clearly there is more than one possibility, as was the case in ***Novo Industries*** as well. In such a case, one must show that one of ordinary skill in the art would have been able to determine for sure what was intended, ***Ex parte Brodbeck***, 199 USPQ 230. See also ***Central Admixture Pharmacy Services Inc. v. Advanced Cardiac Solutions P.C.***, 82 USPQ2d 1293, where the criterion was "whether the error and its correction would both be clearly evident to one of skill in the art". Similarly, MPEP 2163.07 states that correcting an error without introducing new matter requires "one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction." Such a burden has not been met.

Applicants state that such a choice is "clear from the application" as a choice for a substituent on R4, etc, but present no evidence at all. The fact that P appears elsewhere in the specification in a totally different context has nothing to do with this substituent.

Applicants argue that Se is never mentioned elsewhere in the specification. This argument seems to be based on an implicit assumption that an element cannot have been

intended to appear in only one place. There is no reason for such an assumption. Indeed, the element As appears only once.

Applicants continue: "In addition to that, one of ordinary skill in the art would know that an error in an index/valency is surely much more likely than the citation of a wrong atom." There is no actual basis for the assertion in the first sentence, but even if it were true, that is not the legal standard. The standard is not the question of what is a more common error and a less common error. The standard is whether the correct answer is "clearly evident", and whether there could be "reasonable debate" as to the correct choice. With five choices, the correct answer is not clearly evident.

Applicants continue: "And the correction of an index also has much less impact on the general principle of the invention than the change of an atom." It is not is clear what this means. But at any rate "impact on the general principle of the invention" is not the correct criteria, as indicated above.

Even if the element were taken as P, applicants state, "To be chemically correct the formula must therefore read $-PO_3(M_1)_2$. But this is not true. Applicants are assuming that the missing piece must be M_1. Maybe the missing piece was just H, i.e. the original language of $-PO_3(M_1)$ conveys the idea that only a mono salt was intended, so that the actual correct form was $-PO_3H(M_1)$. Applicants have presented no reasoning as to why it would be clear that the missing piece was the broader M_1 rather than H. After all, leaving out an H is a fairly common error. Or perhaps the missing group was R, an esterifying group.

Claims 14 and 51-57 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The end of the R definition, " or an -NH_2 (C_1-C_4-alkyl)NH-, (C1-C4-alkyl)$_2$N-," is unclear. Are these choices for R itself, or are these choices for substituents on the phenyl? The claim could be read either way. For whichever choice is selected, applicants must show that one skilled in the art could have figured out that this choice, and not another, was surely intended.
2. The text "or both R31 together denote oxadimethylene" is unclear. It could mean a) dimethylene, in which one of the carbons is replaced with an oxygen atoms, hence -O-CH_2- or -CH_2-O- or b) two methylene groups separated by an oxygen, hence -CH_2-O-CH_2-. For whichever choice is selected, applicants must show that one skilled in the art could have figured out that this choice, and not another, was surely intended.
3. In the definition of the divalent radical R6, there is this choice: "methylene-4-pyrrolidine-4-yl". It is unclear what this is. It would appear that there is a methylene group, i.e. =CH_2, at the 4-position of the pyrrolidine, which is itself bonded at the 4-position. But that would give only a monovalent radical, and the C at that 4-position would have 5 bonds. Also, there is the issue of what else is present, since for something to be called the 4-position, there must be something else at the 2-position, otherwise, the 4-position would be properly called the 2-position. It would be helpful if applicants drew this linking moiety and showed how this term is correct.
4. In the R28 and R6 definition there appears C_1-C_8 acyl as a substituent. The term "acyl" is indefinite. Does this embrace acids of S? P? As? What does the stem look like, i.e. if

the acyl is e.g. RC(O), what is R? In carboxylic acid acyls, does the carbon count include the carbon of the carbonyl? That is, would this or would this not include H-C(O)- and $C_8H_{17}C(O)$-?

Specification

The amendment to the specification adding $-PO_3(M_1)_2$ is objected to as new matter for reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner, Art Unit 1624

9/25/2009